

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 50

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWIN P. BEIERLORZER

Appeal No. 95-4375
Application 08/153,491¹

HEARD: MARCH 4, 1998

Before McCandlish, *Senior Administrative Patent Judge*, Meister and STAAB, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision in an appeal from the final rejection of claims 18-25 and 28-36, all the claims in the application.²

¹ Application for patent filed November 17, 1993. According to appellant, the application is a continuation of Application 07/861,225, filed March 31, 1992, now abandoned.

² Although the record indicates that the amendment filed concurrently with appellant's main brief (Paper No. 30) has been

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Subsequent to the final rejection, the examiner has reconsidered his position and withdrawn the rejections of claims 21-24 (answer (Paper No. 31), page 5), claims 31, 33 and 34 (answer, page 6), and claims 20 and 28 (supplemental answer, page 1).³ Accordingly, only the rejections of claims 18, 19, 25, 29, 30, 32, 35 and 36 remain before us for review.

Appellant's invention pertains to an apparatus for (claims 18, 19 and 35) and a method of (claims 25, 29, 30, 32 and 36) producing, from a substantially continuous web of paper, a paper product comprising a plurality of sequentially folded strips of paper. An understanding of the invention can be derived from a reading of exemplary apparatus claim 18 and exemplary method claim 25, copies of which appear in the appendix to appellant's main brief.

In rejecting the claims under 35 U.S.C. § 103, the examiner relied upon the references listed below:

entered (see the supplemental examiner's answer (Paper No. 34)), this amendment has not yet been clerically entered. This manner should be corrected upon return of the present application to the examiner.

³ Although not expressly stated, it is presumed that these claims are now considered by the examiner to be directed to allowable subject matter in that they are no longer subject to any grounds of rejection.

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Parker	5,088,972	Feb. 18, 1992
Parker	5,173,352	Dec. 22, 1992 (filed Jun. 14, 1990)
Pollux Trust (Swiss Patent)	666,225	Feb. 6, 1952

Claims 18, 19, 25, 29, 30 and 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Parker '352 in view of Pollux Trust.

Claims 18, 19, 25, 29, 30, 32, 35 and 36 stand rejected under 35 U.S.C. § 103 as being unpatentable over Parker '972 in view of Pollux Trust.

The Parker references represent appellant's prior art jumping off point. Each of the Parker references discloses an apparatus and method wherein sequentially folded strips of paper are produced from a substantially continuous web of paper by restricting the forward advancement of a plurality of strips of paper in such a manner that the natural resilience of the paper produces substantially uniform adjacent opposite folds. The examiner concedes that neither of the Parker references discloses "a moistening device which moistens the withdrawn section of paper thereby forming a moistened section of paper," as called for in independent apparatus claim 18, or the step of "moistening the withdrawn section of paper to form a moistened section of

paper," as called for in independent method claim 25.

Pollux Trust pertains to an apparatus for producing an article composed of superimposed layers of smooth and embossed paper bonded together to form a laminated cushion pad. In the apparatus of Pollux Trust, paper rolls 2 and 4 supply stock paper to moistening devices 8 and 10 where the paper webs 5 and 7 are moistened. The webs 5 and 7 then pass through embossing mechanisms 13 and 14 where they are embossed with a pattern. Simultaneously, paper roll 3 supplies stock paper to a gumming mechanism 16 where the paper web 6 is gummed on both sides. The webs 5-7 are brought together at the location of roller 17. This three layer construction is then fed into stamping machine 20 along with webs 21 and 22, the latter webs being gummed on their inwardly facing sides by gumming mechanisms 16¹ and 16² prior to entry into the stamping machine. The five layer construction that emerges from the stamping machine is cut into finished cushion pads 27¹ by cutters 25 and 26.

In rejecting the appealed claims, the examiner has taken the position that it would have been obvious to one of ordinary skill in the art to moisten the withdrawn strips in either of the Parker references "because it enables more rapid working of the paper and helps durably set the form to be imparted as taught by

Pollux Trust" (final rejection, page 2). While acknowledging that Pollux Trust does not disclose that a moistening step would be beneficial in a method like that of the Parker references, the examiner contends that

this point has no bearing on the application or the reasons why one of ordinary skill in the art would be motivated by the combination of Pollux and Parker to apply moisture to a sheet of paper. Pollux does disclose that applying moisture to a paper sheet would be helpful in the deformation of a paper sheet. Thus, the combination of Parker and Pollux would motivate one of ordinary skill in the art to apply moisture to a sheet of paper "in order to make the subsequent embossing durable and by this means to obtain the conditions for a rapid working." (page 3, lines 64-67 of Pollux). Furthermore, Pollux is considered analogous art in that it deals with the same type of problem that the appellant's invention addresses, i.e., increasing the workability of the paper in a paper deforming device and increasing the durability of the folded/embossed area [answer, pages 4-5]

While we appreciate the examiner's position, we do not agree that it would have been obvious, in view of Pollux Trust, to modify either of the Parker references in the manner proposed. In essence, we consider that the subject matter of Pollux Trust is too far-removed from that of the Parker references to have suggested modifying the latter in the manner proposed by the examiner. Although both the Parker references and Pollux Trust broadly deal with deforming paper material, the Pollux Trust apparatus utilizes positive forming devices (i.e., embossing mold

or die mechanisms 13, 14) having surfaces corresponding to the intended shape of the final product to impart a shape to the paper webs 5 and 7. A device of this sort is simply not present in the Parker references, where, in contrast, the folding of the paper strip is accomplished solely by restricting the forward advancement of the strips in the discharge chute. The examiner seemingly ignores these differences in structure and operation between the primary references and Pollux Trust which point away from their combination by shifting to a higher level of commonality, namely, that the ultimate goals of each are to deform paper. These broadly defined ultimate goals do not justify the examiner's proposed modification of the primary references. In this regard, it is not at all clear that the moistening devices of Pollux Trust, which are for the purpose of "mak[ing] the subsequent *embossing* durable" (Pollux Trust, page 3, line 65; emphasis added) would be of any benefit whatsoever in the paper forming apparatus and method of the Parker references.

In our view, the only suggestion for combining the disparate teachings of the Parker references and Pollux Trust in the manner proposed by the examiner stems from hindsight knowledge derived from appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C.

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§ 103 is, of course, impermissible. *See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). It follows that we cannot sustain the examiner's rejection.

The decision of the examiner is reversed.

REVERSED

HARRISON E. McCANDLISH)	
Administrative Patent Judge)	
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JAMES M. MEISTER)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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LAWRENCE J. STAAB)	
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